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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/808,327	03/14/2001	Michel Cosmao	PF000022	3864
24498	7590	04/21/2006	EXAMINER	
THOMSON LICENSING INC. PATENT OPERATIONS PO BOX 5312 PRINCETON, NJ 08543-5312			ONUAKU, CHRISTOPHER O	
			ART UNIT	PAPER NUMBER
			2621	

DATE MAILED: 04/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/808,327

**Applicant(s)**

COSMAO ET AL.

**Examiner**

Christopher Onuaku

**Art Unit**

2621

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 8-16 is/are rejected.
- 7) ☒ Claim(s) 6 and 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/14/01</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### **ABSTRACT**

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

2. The abstract of the disclosure is objected to because the abstract contains more than one paragraph. Correction is required. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 2621

4. Claims 1-5,8&10-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Zigmond et al (US 6,698,020).

Regarding claim 1, Zigmond et al disclose methods and systems for selecting and inserting advertisements into a video programming feed at the household level, comprising the steps of receiving audiovisual transmissions and at least one service information item, which are broadcast by the broadcasting center, displaying an audiovisual transmission received, reading an audiovisual transmission recorded (recorded advertisements) and displaying the audiovisual transmission read while replacing at least part of the audiovisual transmission received, the displaying of the audiovisual transmission read while replacing at least part of the audiovisual transmission received being triggered at a moment defined by the service information item (see Fig.6&7; col.17, line 10 to col.18, line 37), advertisements (audiovisual transmission) are selectively received and stored, video programming (audiovisual transmission) is received and displayed, then the video programming is interrupted to add selected advertisements from the stored advertisements to the displayed video programming, and when the adding of the selected advertisements is finished, the displaying of video programming is resumed.

Regarding claim 2, Zigmond et al discloses wherein it comprises a step of recording in a non-volatile storage means at least one transmission broadcast prior to the second displaying step ( i.e., displaying the audiovisual transmission read while replacing at least part of the audiovisual transmission received), the transmission

Art Unit: 2621

possessing a characteristic in common with the transmission or transmission part replaced in the second displaying step (see col.17, lines 10-32 and col.8, lines 29-38), here the advertisements are downloaded and stored in advertisement repository 86 of Fig.5.

Regarding claim 3, Zigmond et al disclose wherein the recording of the transmissions is conditioned by the result of a comparison between a criterion written in the memory of the receiver and a data item broadcast in a service information item characterizing the transmission to be recorded (see Fig.5 and ad filtering device 84; col.15, lines 18-23 and col.17, lines 10-20), here the ad filtering device 84 filtering advertisements based on the advertisement selection criteria.

Regarding claim 4, Zigmond et al disclose the method wherein the recorded transmissions are identified by a topic, the written criterion corresponds to a user profile, and that the condition of recording of the transmission is the correspondence between this topic and the written data (see Fig.5 and ad filtering device 84; col.15, lines 18-23 and col.17, lines 10-20 and col.19, lines 54-61), here the ad filtering device 84 filtering advertisements based on the advertisement selection criteria, including user profile

Regarding claim 5, Zigmond et al disclose the method wherein it comprises a prior step of selecting a user profile from among a plurality of specified profiles (see col.1, lines 36-43 and col.19, lines 54-61).

Regarding claim 8, Zigmond et al disclose the method wherein it comprises a prior step of recording a minimum specified quantity of recordable broadcast transmission, before the execution of the second step (see col.16, lines 20-30), here the ad storage capability, perhaps two or three adds for each time slot, and receive the ads encoded in the broadcast signal before selection and display.

Regarding claim 10, Zigmond et al disclose methods and systems for selecting and inserting advertisements into a video programming feed at the household level, comprising:

a) a means of receiving transmissions transmitted from a broadcasting center (see Fig.7; ad insertion device 56; national broadcaster 18 and cable network 30; col.17, lines 50-63);

b) a memory containing at least one audiovisual transmission (see Fig, 5, advertisement repository 86; col.15, lines 18-34);

c) a means for displaying the transmissions (see Fig.7, display device 58; col.17, line 64 to col.18, line 6);

d) wherein the transmission broadcast by the center are of two types, the type of the transmissions being identified by a characteristic contained in a service information item transmitted by the broadcasting center (see Fig.4&5; the pre-filtered advertisement pre-filtered by the filter device 84 and stored in advertisement repository 86; and the video programming from the video programming source 66; col.15, lines 18-23) and in

that the decoder further comprises a first means of detecting the change of type of the transmissions received by the reception means (see Fig.5, switch decision unit 88 and the video switch 90; col.15, lines 35-65) and means of selecting the transmissions so as to display either transmissions of the first type currently being broadcast or transmission recorded in the memory, the selecting means is controlled by the detecting means in such a way that the broadcasting of a transmission of the second type causes the displaying of a recorded transmission recorded in the memory (see col.17, lines 10-48).

Regarding claim 11, Zigmond et al disclose means of recording in the memory at least one broadcast audiovisual transmission, wherein the first detecting means authorizes the activation of the means of recording a transmission of the second type upon the detection of the broadcasting of the transmission of the second type and in that the selecting means allows the displaying of the transmission of second type previously recorded (see Fig.6; col.17, lines 10-48), here the advertisement reads on the claimed second type audiovisual transmission.

Regarding claim 12, Zigmond et al disclose wherein it further comprises a temporary storage memory for recording transmissions of the first type (video programming) broadcast by the center, and a second means of detecting the end of the display of a recorded transmission (pre-filtered advertisement) , the first detecting means detecting the reception of a transmission of the first type activates the second means and causes the recording in temporary storage memory of the transmission of

Art Unit: 2621

the first type, the second detecting means detecting the end of the displaying of a recorded transmission causes the displaying of the content of the temporary storage memory (see Fig.6&7; col.17, line 10 to col.18, line 28), here the programming feeds 38&39 (claimed first type include video programming) are received at household 56, and temporarily stored before being displayed.

Regarding claim 13, Zigmond et al disclose wherein it comprises a means of selecting the transmission of the second type broadcast according criteria stored in the receiver, only the selected transmissions are recorded in the memory (see Fig.5; filter device 84 and advertisement repository 86; col.15, lines 18-34).

Regarding claim 14, the claimed limitations of claim 14 are accommodated in the discussions of claim 4 above.

Regarding claim 15, Zigmond et al disclose wherein the transmission of the second type are broadcast on a different communication channel from that of the transmission of the first type, and in that the receiver possesses a second reception means for receiving transmissions from the communication channel broadcasting transmissions of the second type (see Fig.7; national broadcaster 18 and cable network 30 that transmit programming feeds 38&39 containing video programming (first type) and AD source 62 that transmit the advertisement stream 64 (second type) to the satellite service provider 130 from different communication channels.

Regarding claim 16, Zigmond et al disclose wherein it comprises a memory capable of previously recording a block of audiovisual transmissions, and a means of reading this block, upon display, the reception means is replaced by the reading means (see Fig.6; col.17, lines 10-32)

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond et al.

Regarding claim 9, Zigmond et al fail to explicitly disclose the method wherein new recordings are prohibited as long as none of the current recordings has been read, the reading of a recording giving rise to its erasure from the non-volatile storage means, but this would have been an obvious engineering design consideration depending on the circuit at hand.

***Allowable Subject Matter***

7. Claims 6&7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claim 6, the invention relates to digital television receivers/decoders, including a process for displaying audiovisual transmissions broadcast by a center and a receiver of audiovisual transmissions.

The closest reference Zigmond et al (US 6,698,020) disclose methods and systems for selecting and inserting advertisements into a video programming feed at the household level.

However Zigmond et al fail to explicitly disclose a process for displaying audiovisual transmissions in a digital television receiver, the transmissions being broadcast from a broadcasting center, the receiver being furnished with a means for displaying the transmissions where the process further comprises wherein it comprises a third step consisting in recording in a temporary memory of the receiver the non-recordable transmission broadcast immediately after a recordable transmission and in displaying the content of this memory, the displaying and the broadcasting of the transmission being shifted by a certain time

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Dimitrova et al (US 6,100,941) teach the field of video recording and playback systems, including a method and apparatus for locating a commercial within a video data stream.

Lewine (US 5,668,917) teaches the field of recording television programs, specifically automatically eliminating television commercials from the recorded program

Art Unit: 2621

without requiring the television broadcaster to provide a fade or other special signal to indicate the start and end of commercials.


Killian (US 6,163,316) teaches the field of television viewing and recording, including an electronic programming system and method.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Onuaku whose telephone number is 571-272-7379. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on 571-272-7950. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
COO  
4/7/06.

  
THAI TRAN  
PRIMARY EXAMINER